

**REMARKS / ARGUMENTS**

By this amendment, claims 4, 6, and 11 are canceled; claim 12 is amended; and new claims 30, 31, and 32 have been added. No new matter has been introduced. Claims 1-3, 5, 7-10, 12-32 are pending. The Examiner has allowed claims 20-29. Claims 4, 6, and 11-13, which were rejected as being based on a rejected base claim, were indicated by the Examiner to be allowable if rewritten in independent form. Accordingly, Applicant has rewritten claims 4, 6, and 11 as new independent claims 30, 31, and 32, and amended claim 12 to comply with the Examiner's suggestion. Furthermore, Applicant has amended paragraph [0019] of the specification, as required by the Examiner, to include a brief discussion of Figs. 5A, 5B, and 5C. In light of same, and in light of the following remarks, allowance of all pending claims is respectfully requested.

**Rejections under 35 U.S.C. §103**

Claims 1-3, 5, 7-10, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Haskell, Molina and Price; or Haskell, Molina and Marlow.

The instant invention claims a system for appendage elevation comprising a first base; a second base adapted to be supported between opposing surfaces; a support assembly with a first end and second end; a hook operably attached near the first end of the support assembly; a connector with a first end and second end, the first end of the connector operably attached to the second end of the support assembly, and the second end of the connector being removably insertable into the first base and the second base; a sling assembly; and a means for removably attaching the sling assembly to the hook.

Haskell reports a head traction device having a single base member.

Molina reports a surgical support apparatus having a sling and a mounting assembly. The Molina device consists of a single base member that clamps onto an operating table.

Price reports a portable intravenous pole in which a victim lays on top of a base member to support an intravenous delivery system. The pole includes a single base disposed perpendicular and fixedly coupled to one of the segments at its first end adjacent to the bottom of the pole. The base contains a pair of flat elongated legs.

Marlow reports a lower back support system having a support frame and support belt. The support frame is an open, rectangular frame having a base rod with two swivel arms. The

base is positioned to grip a seat via the swivel arms. Only a single base is disclosed by the Marlow patent.

In determining obviousness under 35 U.S.C. § 103(a), the Examiner must consider the claimed invention as a whole. “The question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP § 2141.02 (citing *Stratosflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983)). Not only must the claimed invention be considered as a whole, the prior art references must be considered as a whole and must suggest the desirability of the combination. MPEP § 2141.01 (citing *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986)). Furthermore, although a prior art device may be capable of being modified to operate in the way in which an applicant’s apparatus is claimed, there must be a suggestion or motivation in the reference to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Finally, the prior art must teach or suggest all the claim limitations. MPEP § 2142; 2143.

Applicant respectfully submits that the cited references do not teach nor suggest an appendage elevation system having a first base, a second base adapted to be supported between opposing surfaces, and a connector that is removably insertable into the first base and the second base. Applicants claimed features allow the interchange of the first base and second base with the support assembly of the appendage elevation system. The interchange of bases provides for unlimited vertical adjustment of the support assembly. In addition, it does not confine the patient to a single location, such as a chair or bed. In other words, multiple settings are provided by Applicant’s single system. With regard to the first and second base, as described above, none of the references teach or suggest an appendage elevation system having more than one base. Furthermore, none of the cited references teaches or suggests the capability of alternating an appendage elevation system from one base to another as claimed in the present application. These references, considered as a whole, do not teach or suggest an appendage elevation system containing two interchangeable bases. Thus, these references do not teach or suggest all the claimed limitations. Moreover, no motivation in these references, or in the art exists to suggest the desirability of the combination of references presented by the Examiner to show Applicant’s claimed system is obvious.

In addition, with respect to the specific structure of the second base, the Office Action asserts that “the addition of a well-known structure such as the recited additional second base adapted for inserting between opposed surfaces is only a matter of obvious engineering design choice, and provides no unexpected result.” Applicant respectfully disagrees that such structure is “well-known” or that it would be considered an “obvious engineering design choice,” as none of the prior art references cited within this application contain the specific recited structure of the second base and use thereof with the present invention. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Modifications of the prior art to meet the claimed invention upon the basis that the claimed invention would have been “well within the ordinary skill of the art” at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP § 2143.01 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). As the prior art does not demonstrate such a unique structure for an appendage elevation system, it is difficult to see how such a structure could have been suggested as obvious at the time the invention was made. Accordingly, Applicant respectfully requests the Examiner provide evidence of such well-known structure in the form of a prior art reference or affidavit, in support of the Examiner's assertion as provided under MPEP § 2144.03. If such prior art cannot be provided, Applicant respectfully requests the Examiner withdraw the rejection based on “well-known” art.

In addition to the above, Claims 14-17 stand rejected under 35 U.S.C. § 103(a) as obvious over Haskell, Molina and Price; or Haskell, Molina and Marlow, in further view of Blatt.

The teachings of Haskell, Molina, Price, and Marlow are discussed above.

Blatt reports a sling consisting of a flexible, L-shaped envelope, a shoulder strap, a rear support assembly for coupling the strap to the rear of the envelope, and a forward support assembly for coupling the strap to the envelope. The strap of Blatt can be formed into a large loop and hooked over a separate support mounted on a bed or a chair.

Blatt does not teach or suggest an appendage elevator system with the recited structure of the independent claims, nor does Blatt specifically teach or suggest an appendage elevator

system having two interchangeable bases. Instead, Blatt merely teaches a sling that can be hung from a support.

As illustrated above, Haskell, Molina, Price, and Marlow do not teach or suggest Applicant's claimed invention. Furthermore, Blatt cannot be combined with any of these references to show Applicant's entire claimed invention.

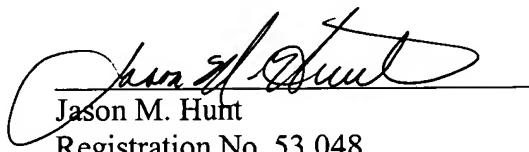
Taken together, Applicant respectfully submits that an appendage elevation system of the structure claimed by the instant application, containing a first base, a second base adapted to be supported between opposing surfaces, and a connector that is removably insertable into the first base and the second base, is a novel property not disclosed by the prior art references, and that the independent claim 1 and the claims dependent thereon, rejected by the Examiner, are not obvious over the cited prior art references. Accordingly, withdrawal of the 35 U.S.C. § 103 rejections is respectfully requested.

### CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that this application is in condition for allowance and such action is earnestly solicited. However, should the Examiner have any further point of objection, the Examiner is urged to contact the undersigned so that a mutual agreement with respect to claim limitations can be reached.

Respectfully submitted,

Date: 10/2/03



Jason M. Hunt

Registration No. 53,048

Dorsey & Whitney LLP

801 Grand Ave., Suite 3900

Des Moines, IA 50309

Telephone: (515) 283-1000

Fax: (515) 283-1060

ATTORNEY FOR APPLICANT